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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,167	07/11/2001	Kenichiro Suetsugu	43888-112	7945
20277	7590	07/06/2005	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			PHAN, THIEM D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SA

Office Action Summary	Application No. 09/889,167	Applicant(s) SUETSUGU ET AL.	
	Examiner Tim Phan	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8, 11-14 and 21 is/are pending in the application.
 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 6-8, 14, 21 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on 05/16/05 has been fully considered and made of record.
2. The rejection of claims 6-8, 14 & 21 which were rejected in Office Action mailed on 2/22/05 under 35 USC 103; these claims are rejected under 35 USC 103 herein for substantially the same reasons as provided in the previous Office Action which is incorporated herein and made a part hereof.

Response to Arguments

3. Applicants' arguments filed 05/16/05 have been fully considered but they are not persuasive for the following reasons:

Applicants urge in section A (Remarks, pages 3 & 4) that there is no suggestion to identify the type and composition of the solder. The examiner's position, as stated in the previous action, continues to be that since Asao et al teach the identification of different levels of solder for the benefit of environment pollution and Nakatsuka et al teach also different solder composition to be used in electronic parts for the benefit of environment pollution. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine the two teachings by applying the information of the lead free solder as taught by Nakatsuka et al to the

bar code of Asao et al, in order to speed up and simplify the recycling of used parts without harming the environment. In response to applicantss argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Asao et al and Nakatsuka et al have their utmost motivation or goal or recycling used parts and avoid harming the environment, specially by the presence of lead heavily used in the electronics industry.

Applicants' citations in section B (Remarks, pages 4 & 5) that Asao et al's bar code does not indicate lead information, which are traversed since Asao et al teach that "The first decision reference is the absolute amount of heavy metal or the like **represented by lead** and shown in the first digit (Asao et al, Abstract, lines 18 & 19).

Applicants urge in section C (Remarks, pages 5 and 6) that it is not obvious to have an identification in the housing and neither Asao et al nor Nakatsuka et al suggest an obviousness to have that housing identification and to request a documentary evidence of the findings. Indeed, Asao et al teach the **processing and recycling of a housing or an electrical machinery or an apparatus** (Asao et al, Detailed Description, paragraph 1). It would be obvious to one of ordinary skill in the art at the time the invention was made to apply the information of the lead free solder as taught by Nakatsuka et al to the bar code or labeling of Asao et al, and have it

imprinted on the housing or an electrical machinery or an apparatus in order to facilitate the recycling, which accommodates the printed circuit boards or articles or have it imprinted to the box carrying these housings or the trucks, the trains or boats, etc ... carrying these boxes in order to speed up and simplify the recycling of used parts without harming the environment. Moreover Applicants urge that “Asao et al requires the electrical appliance to first be disassembled before recognizing the bar code ...” ((Remarks, page 6, 3rd paragraph) which are not taught by Asao et al and nowhere to be found.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In

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no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M - F, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Phan
Examiner
Art Unit 3729

tp
June 30, 2005



A. DEXTER TUGBANG
PRIMARY EXAMINER